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10/629,511	07/29/2003	John C. Jeppesen	6553-0501	6911
24936	7590	10/19/2005	EXAMINER	
RALPH D CHABOT 2310 E PONDEROSA DR SUITE 4 CAMARILLO, CA 93010			BUNIN, ANDREW M	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.



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88

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER

101405

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Commissioner for Patents

The reply filed on 8/3/05 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant fails to address an election requirement of the patentable distinct species in claims 36 and 37 as stated below. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Election/Restrictions

Examiner had inadvertently drawn the groups of claims to an incorrect class and/or subclass in previous action. Therefore, correction has been made below to correctly place the subject matter in its appropriate class and subclass. In addition, not that Group III and IV have been combined in view of applicant's amendment.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Claims 1-3, 5, 6, 8-10, and 38 drawn to a method for treating Obstructive Sleep Apnea Syndrome (OSAS) with positive airway pressure (PAP), classified in class 128, subclass 204.18.

Claims 11, 13, and 15-17 drawn to a device, which obturates the oral cavity during treatment of OSAS, classified in class 128, subclass 848.

Claims 18-23, 25, 28, 29, 31, 32-37, and 39 drawn to method of applying PAP to nasal passages, classified in class 128, subclass 206.11.

Restriction of Groups I, II, III continues to be upheld based on the statements below:

Inventions of Group I or Group III and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the method for treating a patient having OSAS involves the connection of tubes to a source of positive airway pressure whereas the tubing of the device in Group II isn't necessarily connected to a source of positive pressure. Although the tubing is labeled as positive airway pressure tubing, it may still be connected to ambient pressure or a source of negative pressure. Therefore, the apparatus used in Group I or III must include connection to a source of positive airway pressure whereas the device of Group II may be connected to ambient or negative pressure.

Inventions of Group I and Group III are related as combination and subcombination. Inventions in this relationship are

distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the device in Group I doesn't need or include fabricating the dual arch oral appliance especially for preventing mouth venting of PAP and positioning oral appliance to maintain patient's mandible in a substantially neutral centric position **without protrusion of the mandible**. The subcombination has separate utility in that the PAP system can be separated from the mouthpiece section and be used on its own for ventilating a patient. In addition, the mouth guard or mouthpiece can function on its own in order to obturate the oral cavity as shown throughout the dental arts.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II or III, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: Within Group III, claims 22 and 23 describe a PAP Tubing Retention Platform as being vacuum formed or created via injection molding.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 18 is generic since it describes the use of the same PAP Tubing Retention Platform further in claims 22 and 23.

This application contains claims directed to the following patentably distinct species of the claimed invention: Within Group III, claims 36 and 37 describe capturing a neutral centric position via Transcutaneous Electrical Nerve Stimulation (TENS) or via conventional techniques such as manual physical manipulation of the mandible.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 33 is generic since it describes the use of the same dual arch appliance further in claims 36 and 37.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant's election with traverse of Group III (claims 18-23, 25, 28, 29, 31, 32-37, and 39) in the reply filed on 8/03/05 is acknowledged. The traversal is on the ground(s) that examiner didn't show burden with separate classification and Group I and II are related as process and apparatus with applicant's amendment. However, this is not found persuasive because examiner has corrected the classification of Groups I-III and has shown that these Groups continue to be patentably distinct entities as disclosed above in view of applicant's amendment.

Henry Bennett
Supervisory Patent Examiner
Group 3708